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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,608	07/03/2003	Glenn Butler	LS-001	7297
31647	7590	03/18/2005	EXAMINER	
DUGAN & DUGAN, P.C. 55 SOUTH BROADWAY TARRYTOWN, NY 10591			JOHNSON III, HENRY M	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,608

Applicant(s)

BUTLER, GLENN

Examiner

Henry M Johnson, III

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 and 15-17 is/are allowed.
- 6) ☐ Claim(s) 1-8, 10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments filed March 3, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known that LEDs produce non-coherent, divergent radiation resulting in a reduction in intensity as the distance increases. Since the radiation dose is dependent on distance, a means to determine a distance from the source to the target would be an obvious combination. The disclosure of a distance detecting sensor by Bahk is sufficient to provide that capability. The intended use of Bahk is irrelevant in an apparatus claim.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., clinically repeatable dosages and sufficient amount of light to have a therapeutic effect) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art relied on for the rejection of an apparatus claim must be capable of meeting the claim limitations. Diamantopoulos et al. provide a handheld device that is capable of being positioned manually using the visible light and distance sensor (Bahk) to yield a succession of repeatable placements of the treatment device.

Art Unit: 3739

The applicant states that Zavislan et al. do not suggest using an imaging system for positioning an array. The claims require the image mechanism to be positioned. Since Zavislan et al. clearly teach the desirability of imaging treated tissue, the logical combination would be for the imaging device to be on the handheld unit of Diamantopoulos et al. The imaging mechanism is not claimed to control the targeting mechanism, only to be coupled to it.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,930,504 to Diamantopoulos et al. in view of U.S. Patent Application Publication US 2004/0215176 to Bahk. Diamantopoulos et al. teach a device for biostimulation of tissue (abstract) using a cluster probe with multiple LEDs (array). Ten 880 nm LEDs are positioned around the circumference and additional LEDs of other wavelengths (i.e. 660 nm) are positioned within the circle of 880 nm LEDs. The LEDs may be uniformly dispersed (Fig. 7). The different wavelengths of LEDs are broadly interpreted as separate arrays. Control circuits are provided to power the arrays (Fig. 4). The visible wavelength LEDs (660 nm) can be used as a targeting mechanism as they illuminate the target area and are coupled to the array as they are integral to the probe. The handle of the probe provides a positioning capability and is interpreted as a positioning device. Regarding the interpretations of targeting and positioning, "During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has

Art Unit: 3739

provided a clear definition in the specification" (MPEP § 2111.01). Clear definition must not be confused with specific limitations. Diamantopoulos et al. do not teach a ranging capability. Bahk teaches a laser diode device for medical treatment that includes a distance sensor to measure the distance between the irradiated surface and the lens (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the ranging device as taught by Bahk in the device of Diamantopoulos et al. as it is well known the divergent radiation of an LED yields an intensity that is distance dependent.

Regarding claim 11, the method of use of the Diamantopoulos et al. device is inherent in its structure. Arrays of LEDs are provided with specific wavelengths with the intended use of irradiating a tissue area. The device must be positioned to accomplish this use (Col. 9, line 64 to Col. 10, line 19).

Claims 7, 8, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,930,504 to Diamantopoulos et al. in view of U.S. Patent Application Publication US 2004/0215176 to Bahk and further in view of U.S. Patent 5,860,967 to Zavislan et al. Diamantopoulos et al. and Bahk are discussed above, but do not disclose imaging of a treated area. Zavislan et al disclose a handheld irradiation device that includes a CCD in the handpiece for imaging the treated area (abstract). Zavislan et al teach the need for a visualization system for tissue such as skin and other non-ocular tissue (Col. 2, lines 5-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the imaging device of Zavislan et al in the invention of Diamantopoulos et al. as modified by Bahk to capture an image of the treated area as suggested by Zavislan et al. The control circuitry of Diamantopoulos et al. is capable of controlling (beam control logic) the target visible light as required in claim 10.

Art Unit: 3739

Allowable Subject Matter

Claims 13 and 15-17 are allowed.

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Henry M. Johnson, III
Primary Examiner
Art Unit 3739